

In accordance with the Examiner's telephonic instructions, Applicant is submitting replacement Figures 1-6.

Dependent claims 26 and 43 have been amended to overcome the 36 U.S.C. § 112 rejections. Accompanying this Response are Applicant's marked-up claims as well a clean unmarked-up copy of the amended claims.

In accordance with 37 C.F.R. § 111, request for reconsideration is respectfully solicited as Applicant advances his case toward a patentable conclusion.

REMARKS

1) **Regarding Paragraph 3 of the Office Action**

As previously indicated, replacement drawings requested by the Examiner for Figures 1-6 accompany Applicant's Response. The replacement drawings are in compliance with the Examiner's requirements, i.e., the margins are in conformity with USPTO practice and the reference to the URL has been removed. Applicant requests the Examiner remove the pending objection to Figures 1-6.

2) **Regarding Paragraphs 4, 5 and 6 of the Office Action**

Applicant has amended dependent claims 26 and 43 to overcome the pending 35 U.S.C. § 112 rejections. Claim 26 has been amended to include a controller connected to the headdress. Claim 43 has been amended to include a controller attached to the headdress. With Applicant's invention, it is immaterial whether the controller is connected to the top, bottom, outside or inside of the headdress. Depending on engineering parameters and advertisers preferences, select embodiments utilize public exposure of the controller while other embodiments require the

controller to be hidden from public view. Amended claims 26 and 43 particularly point out and distinctly define Applicant's invention while amended claim 26 is enabled by the Specification.

3) Regarding Paragraph 7 of the Office Action

MPEP 2144.03 indicates an Examiner is only rarely to rely on Official Notice in rejecting claims. In view of United States Supreme Court precedent, it would be better for the MPEP to read that only in the most unusual and rarest of factual scenarios can the Examiner rely on "Office Notice" to reject a claim of an Application. Relying on Official Notice tends to negate the factual content of the record and most of the time fails to meet "substantial evidence test" mandated by the United States Supreme Court in *Dickenson v. Zurko*, 527 U.S. 150 (1999). Therefore, if the Examiner persists in relying on Official Notice in rejecting Applicant's claims, for at least the reasons expressed herein and as a matter of right, Applicant demands the Examiner produce documentary evidence to support rejection of any claim based, in whole or in part, on Official Notice.

Routon does teach that a professional golfer can be paid by a sponsor to wear a visor supporting the sponsor's name or logo during a golf tournament. Applicant agrees with the Examiner; Routon does not teach the displaying of electronic messages as required by independent claims 25 and 32.

The Examiner argues that Gershon teaches the displaying of electronic messages and that it would have been obvious to modify Routon to include the displaying of electronic messages. The Examiner concludes, "It would have been obvious to modify Routon to include displaying electronic messages, because electronic messages can be changed more frequently and can be more colorful and visually appealing to the users." For at least the evidence and law set forth below, since neither Routon or Gershon teach or suggest Applicant's claimed invention, the

Examiner's conclusory statement is based solely on the teaching of Applicant's Specification. Because the Examiner provided no workable and logical reason one of ordinary skill in the art would be motivated to utilize the teachings of Routon in combination with Gershon to make Applicant's invention, what other conclusion can the reasonable trier of fact reach?

Regarding 35 U.S.C. § 103, in the case of *In re Lee*, 277 F. 3d 1338, 1343 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit stated:

In re Dembiczak, 175 F. 3d 994, 999 (Fed. Cir. 1998) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obvious analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F. 3d 1339, 1343 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F. 2d 1071, 1076 ("teachings of references can be combined only if there is some suggestion or incentive to do so.");...*In re Kotzab*, 217 F. 3d 1365 (Fed Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.") *In re Lee* at 1343.

On its face Gershon enables a video game cap having an intended purpose of entertaining the wearer of the game cap. Gershon, Column 2, lines 18-24 read:

It should be noted however that the video game 34 in a general sense is push button-generated visual entertainment and thus should be understood to include visual production of anecdotes, the receiving of new reports, horoscope information of interest to the user, and the like, so long as the changing imagery is responsive to push button operation by the user.

And Column 2, lines 36-45 teach:

In practice, it has been found that the cap-on position of cap 24 obviates loss of the video game 34 since it is more reliable than carrying the video game 34 in a pocket or otherwise on the person of the user. Additionally, as shown in FIG. 5, in the cap-off position, the user 54 can grip the cap 24 with one hand 56 and operate the push buttons 38 with a finger 58 of his other hand 60 and, since the display screen 36 is in facing relation to him, observe the changing images 40 on the display screen 36, all to the end of significantly adding to the play value of the cap 24.

Pursuant to 35 U.S.C. § 103 and based on the facts of Routon and Gershon, one of the relevant inquiries is: why would one of ordinary skill in the art of applying non-electronic logos to the Routon visors look to the Gershon push button activated video game cap to obtain knowledge of how to make a headdress having a plurality of screens displaying electronic messages? Pursuant to *In re Lee*, one of ordinary skill artisan would not. For example, there is no teaching or suggestion, inherent or otherwise, in Gershon, regarding the use of more than one display screen 36. And as noted by the Examiner, Routon “does not teach the headdress to include more than one screen or five planes.”

Before rejecting Applicant’s claims, the Examiner made no findings as to what is the ordinary skill in the art for Applicant’s invention. Nor did the Examiner make particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components used by Applicant for combination in the manner claimed by Applicant to make Applicant’s invention. For example, there is no finding of fact regarding why a professional golfer would wear a visor supporting a plurality of manually controlled and activated electronic message screens during a golf tournament. More likely than, a professional golfer would not wear such a contraption, since it would be cumbersome and would interfere with the professional golfer’s concentration.

The Examiner has not provided any evidence inherent in either Routon or Gershon regarding why one of ordinary skill in the art would be motivated to combine one with the other to make Applicant’s claimed invention. There is no inherent teaching in Routon regarding electronic messages. And since Gershon enables a video game to be utilized by a single video

player, there is no inherent teaching or suggestion of wearing the Gershon cap in a public place to advertise an advertiser's product.

For at least these facts, the Examiner has failed to provide substantial evidence in support of the pending 35 U.S.C. § 103, as required by *Dickenson v. Zurko*.

Instead of findings of fact, as previously indicated, the Examiner has made conclusory statements based on the teachings of Applicant's Application. A case on point is *In re Lee* at 1343-44 (Fed. Cir. 2002) (copy included for the Examiner's convenience), where the Federal Circuit reversed the Board of Appeals and declared:

...neither the examiner nor the Board adequately supported the selection and combination of...references to render obvious that which [the Applicant] described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different devices[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a "tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on the subject belief and unknown authority. "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references simply to "[use] that which the inventor taught against its teacher." [Citation omitted]. Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

The *Lee* Examiner's conclusory statement was reversed by the Court of Appeals for the Federal Circuit is strikingly similar to the current Examiner's conclusory statement rejecting Applicant's pending claims. In short, *Lee* is controlling precedent.

In the Second Office Action, the Examiner has listed some of the elements of the Routon and Gershon devices and concluded it would have been obvious to modify Routon in view of Gershon to obviate Applicant's claimed invention. Apart from the teachings of Applicant's Specification, where did the Examiner find this line of reasoning? Applicant has already

proffered evidence and argument that Examiner has failed to provide substantial evidence, inherent or otherwise, that would motivate one skilled in the art of to combine Routon and Gershon to make Applicant's claimed invention.

The Examiner's erroneous reasoning in rejecting claims 25 and 32 was further compounded by the Examiner veiling the 35 U.S.C. § 103 rejections of Applicant's claims in the cloak of "Official Notice." Applicant's claims 25 and 32 require the critical elements of either "more than one screen" or "five planes." Neither of these critical elements are taught or suggested by Routon or Gershon.

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. *In re Lee* at 1344. (Emphasis by Applicant).

Reliance on "Official Notice" to reject claims 25 and 32 while neglecting to provide any documentary evidence related to the critical elements of either "more than one screen" or "five planes" in the context of Applicant's claimed headress is arbitrary and capricious action forbidden by the Administrative Procedure Act. Applicant's critical elements are relevant factors for which the Examiner has failed to produce any evidence, much less substantial evidence. Shrouding the 35 U.S.C. § 103 rejections of Applicant's claims in "Official Notice" does not pass muster under *Dickenson v. Zurko* or *In re Lee*.

The Examiner has failed to produce substantial evidence or has acted arbitrarily and capriciously or both in rejecting claims 25 and 32. Pending claims 25 and 32 are in condition for allowance. Applicant requests the Examiner to reconsider her pending rejections and allow claims 25 and 32.

4) Regarding Paragraph 8 of the Office Action

Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraph 3 of this Response regarding allowance of independent claim 41. Further, Applicant submits 12 pages of Google images searched for “The Cat in the Hat” and 12 pages of Google images searched for “Clown Hats” (Exhibit 1). The Google record is clear; there are no cubic shaped displayed hats any in of these pages. Further, Applicant searched more than the accompanying Exhibit 1 pages with respect to “The Cat in the Hat” or “Clown Hats” relied on by the Examiner, and the Google image search did not reveal any cubic hats. If cubic hats were as common as the Examiner believes, then it would seem that a Google images search would reveal a plethora of cubic hats rather than a dearth.

Based on the record, it is erroneous of the Examiner to declare “Official Notice” for a cubic shaped hat when the Google images search reveals no such cubic shaped hat. The rejection of claim 41 is arbitrary and capricious and does not pass muster under *Dickenson v. Zurko*. Pending claim 41 is in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejection and allow claim 41.

5) Regarding Paragraph 9 of the Office Action

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraph 3 of this Response regarding allowance of dependent claim 26. Additionally claim 26 was amended to overcome the 35 U.S.C. § 112 rejection.

The Examiner also cited US Patent 5,612,741-Loban, et al. in an attempt to obviate Applicant’s claimed invention. Loban teaches an outdoor video billboard supported by hollow

masts where the billboard utilizes cathode ray tubes or a projector containing a 2500 Watt light source to provide an intensity of at least 4,000 lumens. One of ordinary skill in the art of making Applicant's claimed invention knows that Applicant's headdress is too small to utilize a cathode ray tube or that it would be unsafe for wearer of Applicant's headdress to be irradiated by or exposed to a projected 2500 Watt arc light. Due to the inherent safety issues associated with the Loban reference, one of ordinary skill in the art of making Applicant's claimed invention would be motivated to run away from Loban rather than look toward Loban. Moreover, there is no teaching or suggestion in Routon regarding the use of electronic billboards, nor is there any teaching or suggestion in Loban regarding the wearing of a headdress as a method of advertising. Thus, neither Routon or Loban provides motivation for one of ordinary skill in the art to combine one with the other to manufacture Applicant's claimed invention.

Pending claim 26 is in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejection and allow claim 26.

6) Regarding the first Paragraph 10 of the Office Action

"Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious." *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraph 3 of this Response regarding allowance of dependent claim 27.

Pending claim 27 is in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejection and allow claim 27.

7) Regarding the second Paragraph 10 of the Office Action

"Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious." *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the

reasoning, facts, evidence and law articulated in Paragraph 3 of this Response regarding allowance of dependent claims 28, 29, 35 and 44.

Pending claims 28, 29, 35 and 44 are in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejections and allow claims 28, 29, 35 and 44.

8) Regarding Paragraph 11 of the Office Action

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraphs 3 and 5 of this Response regarding allowance of dependent claims 30, 40 and 49.

Pending claims 30, 40 and 49 are in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejections and allow claims 30, 40 and 49.

9) Regarding Paragraph 12 of the Office Action

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraph 3 of this Response regarding allowance of dependent claim 31.

Pending claim 31 is in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejection and allow claim 31.

10) Regarding Paragraph 13 of the Office Action

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraphs 3 and 5 of this Response regarding allowance of dependent claims 33 and 42.

Pending claims 33 and 42 are in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejections and allow claims 33 and 42.

11) Regarding Paragraph 14 of the Office Action

It is believed the Examiner means “Gershon” instead of “Routon” in this paragraph.

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraph 3 of this Response regarding allowance of dependent claims 34 and 43. Additionally claim 43 was amended to overcome the 35 U.S.C. § 112 rejection.

Pending claims 34 and 43 are in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejections and allow claims 34 and 43.

12) Regarding Paragraph 15 of the Office Action

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraphs 3 and 5 of this Response regarding allowance of dependent claims 36 and 45.

Pending claims 36 and 45 are in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejections and allow claims 36 and 45.

13) Regarding Paragraph 16 of the Office Action

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraphs 3 and 5 of this Response regarding allowance of dependent claims 37, 39, 46 and 48.

Pending claims 37, 39, 46 and 48 are in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejections and allow claims 37, 39, 46 and 48.

14) Regarding Paragraph 17 of the Office Action

“Dependent claims are non-obvious under 35 U.S.C. 103 if claims from which they depend are non-obvious.” *In re Fine*, 837 F. 2d 1071, 1076. Applicant incorporates the reasoning, facts, evidence and law articulated in Paragraph 3 of this Response regarding allowance of dependent claims 38 and 47.

The Examiner states that Routon does not teach the method of these claims and in the same paragraph states that it would have been obvious to modify Routon to include the limitations of claims 38 and 47 without indicating any reference the Examiner would combine with Routon. It is suspected that the Examiner may have meant Loban as the secondary reference, but it is arbitrary and capricious to require Applicant to respond to an unknown reference.

Pending claims 38 and 47 are in condition for allowance, and the Applicant requests the Examiner to reconsider her pending rejection and allow claims 38 and 47.

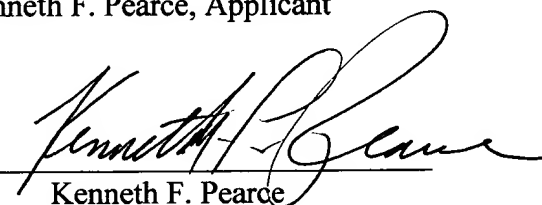
CONCLUSION

In accordance with the Examiner's instructions, Applicant has corrected the drawings.

For at least the facts, law and reason set forth above, all pending claims are in condition for allowance. Applicant has fully traversed all pending objections and rejections averred by the Examiner. Pursuant to 37 C.F.R. §§ 1.121, the required copies of the marked-up and unmarked-up claims accompany Applicant's Response to the Second Office Action. In accordance with 37 C.F.R. § 1.111, Request for Reconsideration is respectfully solicited, as Applicant advances his case toward a patentable conclusion. Applicant believes his Application is in condition for allowance and respectfully requests the same in accordance with Title 35 of the United States Code.

Respectfully submitted,

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